

REMARKS

Applicants acknowledge the Examiner's withdrawal of the obviousness rejection over Bucci in view of Byerly.

On page 2 of the Office Action, the Examiner rejects pending claims 146-205 under 35 USC 112, second paragraph, as being indefinite for failing to active, positive steps of how a use is actually practiced.

In response, Applicant has amended claims 146-175 to positively recite steps in the method. Accordingly, Applicant requests reconsideration and withdrawal of this rejection.

On page 3 of the Office Action, the Examiner has rejected claims 146-175 under 35 USC 101 as failing to define a process without definite steps.

In response, Applicant has amended claims 146-175 to positively recite steps in the method. Accordingly, Applicant requests reconsideration and withdrawal of this rejection.

On pages 3-9 of the Office Action the Examiner newly rejects claims 146-205 under 35 USC 103(a) as obvious over the new combination of Byerly and Bucci of record with a newly cited reference, Masuda (US patent No. 5,569,897).

The Examiner's stated position is that:

"While Byerly and Bucci disclose methods for "how health care reminders may be presented to an end user who conducts a transaction, it is not explicitly disclosed on how the end user's credit card being used in the transaction is issued or used (steps b-e in Claims 146-176). Masuda discloses a system and method for issuing and using credit cards" (Page 5 of the Office Action) which provides the method steps of (c) attracting potential end users by advertising and providing applications for credit cards; (d) converting potential end users by end user accepting and approving

application; and (e) providing a financial card and related services to the approved end user.”

Applicants respectfully submit that one of ordinary skill in the art would not be taught or motivated to make purchases using the combination of Byerly et al and Bucci, in view of Masuda (5,569,987).

Applicants respectfully point out that the presently claimed invention relates to a method for providing medical reminder information relevant to a particular end user as associated with the end users periodic transaction statement.

However, in contradistinction to the presently claimed invention, Byerly merely teaches adding medical advisory information to pharmacy transaction information that is relevant to the pharmaceutical for which the patient had bought through the use of a doctor's prescription.

Bucci is completely unrelated to Byerly, in that Bucci teaches the electronic or computer combination of several financial services transaction accounts into a single printed transaction statement.

Thus, Byerly and Bucci are completely unrelated to each other and also do not in any way teach or suggest the presently claimed method.

Additionally, Byerly and Bucci teach away from each other and thus cannot be properly combined either with each other or together with Masuda. Additionally, the asserted combination can only be combined using impermissible hindsight of the teaching of the present specification. There is no motivation to combine Byerly et al and Bucci due to the fact that the two references “teach away” from each other in three distinct ways, as presented in greater detail below. Only by improperly using hindsight based on the teaching of the present specification would one of ordinary skill in the art combine the teachings of the cited references.

There is no motivation to combine Masuda, Byerly et al and Bucci. The cited references in fact teach away from each other for the combination asserted by the Examiner. The combination of Masuda and Byerly et al would require that Byerly et al teach a credit card issuer, which Byerly completely fails to do. There is no possible relationship between Masuda and Bucci because Bucci also fails to teach or suggest a credit card issuer, where Bucci merely teaches to consolidate bills into a single statement, which has no relationship to the presently claimed invention.

The Examiner at the top of page 6 of the office action generally dismisses the distinction between a health reminder that acts as a health awareness tool that prompts an end-user to self-schedule an appointment without any prompting from a health professional, and a doctor's appointment reminder that reminds a patient of a preexisting appointment. The three-way combination does not teach or suggest providing health reminders to end-users that are not related to the providing of prescription related information that is provided on an invoice for the sale of a certain prescription, as Byerly does.

The "teach away" descriptions presented by Byerly et al and Bucci, are presented in more detail below. In particular, the following establishes that Bucci and Byerly et al "teach away" from each other in three ways: 1) with regards to method of delivery of materials to the end user; 2) with regards to periodicity of the receipt of materials by the end user; and, 3) with regards to when payment is made in relation to the consumption of products or services. In light of the fact that the references "teach away" from each other to such extents, there is nothing in either of the references that would suggest that the motivation for combining the references is known outside of the teaching of the present specification. As a result, the combination can at best be obvious in hindsight, which is impermissible. Accordingly, Byerly and Bucci cannot be combined, and thus cannot also be combined with Masuda.

Additionally, MPEP specifically prohibits the type of combination that the Examiner has made in this rejection, for example, at section 2143.01, and especially as described in detail in this section under the headings toward the end of the section "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART

UNSATISFACTORY FOR ITS INTENDED PURPOSE” and “THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE”.

“TEACH AWAY” COMPARISONS

BUCCI (5,655,089) VS BYERLY ET AL (6,067,524)

WITH REGARDS TO METHOD OF DELIVERY OF MATERIALS TO THE END USER

Bucci: Materials are mailed, or “electronically” transmitted; the end user does not have to *come* to Bucci, Bucci sends the materials *to* the end user.

Byerly et al: The end user picks up the advisory message during the Pharmacy transaction; the end user must come to the retail store environment of a Pharmacy.

Byerly et al refers to retail pharmacy customers or end users as “pharmacy patients” (column 1, lines 21 and 24), or a singular retail pharmacy customer or end user as a “patient” (column 6, line 41). Furthermore, Byerly et al explicitly “teaches away” from *mailing* the “advisory message”, as is seen in column 6, lines 39-48:

“The advisory message **440** can be in the form of a patient-customized newsletter, and it can be delivered to the patient by the pharmacist. Studies have shown that patients regularly use pharmacists as a source of medical information since pharmacists are believed act objectively for the patient's best interests. Accordingly, having the advisory information presented to a patient by his or her pharmacist is a reliable and effective method of providing health advisory information as compared to conventional methods, such as mass mailings, targeted mailings, etc.”

RATIONALE – Bucci and Byerly et al “teach away” from each other with regard to means of delivery. Bucci teaches mailing or electronic transmission, whereas Byerly

et al teaches actual pickup of advisory messages at the pharmacy by the “pharmacy patient” end user, which enables live interaction with the pharmacist, which is deemed by Byerly et al as being desired and greatly preferred to alternatives such as “mass mailings, targeted mailings, etc.” In fact, Byerly et al confirms this “teaching away” from Bucci through evidence that Byerly et al provides no mechanism or contingency *whatsoever* for mailing the advisory messages.

WITH REGARDS TO PERIODICITY OF THE RECEIPT OF THE MATERIALS
BY THE END USER

Bucci: Materials are periodic, and are sent on a specified cycle “during a specified period of time” (column 1, line 64), generally occurring monthly, as seen in column 1, lines 7-9: “This invention relates to the mailing of bills, statements, advertising and other communications to millions of homes and businesses each month”. The examples illustrated in Bucci (column 3, table 1) of billing “subscribers” are as follows: Chemical Mortgage Co., J.C.P.&L., West Keansburgh Water, Hazlet Twp. Sewerage, Storer Cable, Citibank MasterCard, and American Express. All are “subscribers” that send bills on a *monthly* basis; therefore, Bucci sends out the materials on a regular, periodic, and cyclical basis.

Byerly et al: The advisory messages are distributed to end users on a non-regular, non-periodic, non-cyclical basis. In Byerly et al, a given advisory message is relayed to a “pharmacy patient” on an *incidental* basis. The incident that this is based on is the occurrence of a pharmacy transaction. In Byerly et al, a “pharmacy patient” that only gets a single prescription filled a year ends up receiving an advisory message only once during that year, which occurs when said single prescription is picked up by the “pharmacy patient”.

RATIONALE – Bucci and Byerly et al teach away from each other with regard to timing of information delivery, in that in Bucci, the information is delivered on a regular/periodic/cyclical (monthly) basis, while in Byerly et al, the information is delivered on an incidental basis.

WITH REGARDS TO WHEN PAYMENT IS MADE IN RELATION TO THE
CONSUMPTION OF PRODUCTS OR SERVICES

Bucci: The examples illustrated in Bucci (column 3, table 1) of billing “subscribers”: Chemical Mortgage Co., J.C.P.&L., West Keansburgh Water, Hazlet Twp. Sewerage, Storer Cable, Citibank MasterCard, and American Express, are all entities that *bill* the end user, where the accounts are financially settled *after* the end user has consumed the products or services. Even with Chemical Mortgage, the end user is making use of a product (which in this instance is most likely a house), before it is fully paid for. This even applies to the Storer Cable bill (cable bills tend to not be prepaid).

Byerly et al: Byerly et al is in fact a “point of sale” system in a retail store environment of a pharmacy. This is confirmed in column 6, lines 49-50 of Byerly et al:

“The invention represents a significant advance in the field of point-of-sale systems in the pharmacy environment.” As such, said system basically functions “during a pharmacy transaction” (column 2, line 21). The information comprises “billing information” (column 8, lines 5-6), but does it actually comprise a billing statement in the same manner that Bucci does? It indeed does not. In any given pharmacy situation, it is “old and well known” for a “pharmacy patient” end user to financially settle the pharmacy transaction (in other words, pay for the prescription) *prior* to leaving the pharmacy with a given prescription and *prior* to consuming the product (although an exception could result where a pharmacy counter employee could allow a “pharmacy patient” end user to use a not-yet-paid-for inhaler during an acute asthma attack prior to the conclusion of the transaction). Any attempt to thwart payment at a given retail point-of-sale prior to product consumption is generally considered “shoplifting”. In terms of Byerly et al, also it is logical that said “billing information” would also comprise a receipt.

RATIONALE – Bucci and Byerly et al “teach away” from each other with regard to billing practices, in that Bucci teaches where the end user is billed, and the accounts are financially settled *after* the consumption of goods and services take place, whereas

Byerly et al teaches where the end user is billed, and the account is financially settled *prior* to the consumption of the goods by the "pharmacy patient" end user.

Accordingly, Applicant requests reconsideration and withdrawal of this rejection for all of the rejected claims.